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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,039	09/15/2003	Isaak Volynsky	MAT 3H2	1665
23581 7590 05/13/2008 KOLISCH HARTWELL, P.C. 520 SW YAMHILL STREET, Suite 200 PORTLAND, OR 97204			EXAMINER HYLINSKI, ALYSSA MARIE	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 05/13/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/663,039

**Applicant(s)**

VOLYNSKY, ISAAK

**Examiner**

Alyssa M. Hylinski

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 12, 14-21, 25-29, 31-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, 14-21, 25-29, 31-34 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/11/08 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piotrovsky (4470784), Lindsay (3350812), Hales (2129421) and Weis (2174932). Piotrovsky discloses a hollow body portion due to its having a cavity or space therein (Fig. 2) that will form the inner supporting structure of an appendage for a toy figure (Fig. 3) with at least one engagement portion having a first engagement portion in the form of a cylindrical boss (36) for pivotably connecting the insert to another portion of the toy figure such as the torso (Fig. 1) and a second engagement portion formed by a tab (34) that engages the limb portion of the toy (Fig. 2). The boss is attached to the tab (34) which has a convex surface and a plurality of reinforcement

ridges extending from the convex surface and formed to extend perpendicularly outwardly from along the periphery of the tab and extending between the tab and the body for supporting the boss (Fig. 2). The insert is also equipped with a plurality of pins and pegs (56, 46) for stabilizing the insert within a mold so as to injection mold the toy figure (Fig. 8). The insert is shaped to partially conform to an outer surface of the appendage (Fig. 8). The tab and boss each have a substantially semicircular edge that is configured to rotate smoothly within an outer covering of the toy figure (Fig. 2, column 2 lines 58-63). The hollow body insert is meant for use within a toy figure having a torso and limbs (Fig. 1) made of a soft flesh-like outer layer molded over the insert (column 2 lines 58-63). Piotrovsky discloses the basic inventive concept, with the exception of the body portion being configured to maintain a hollow space. Lindsay discloses an insert member (Figs. 1 & 2) having an enclosed tubular body portion for maintaining a space within an appendage of a toy figure being attached to a boss member (Figs. 1 & 2). It would have been obvious to one of ordinary skill in the art to have a portion of the insert be an enclosed tubular member with a boss element since such a modification would have involved a mere change in the shape of the insert. Changes in shape are generally held to be within the level of ordinary skill in the art. *See in re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Piotrovsky and Lindsay disclose the basic inventive concept, with the exception of the tubular member being hollow. Hales discloses an internal insert for a toy doll consisting of hollow tubular members (Fig. 9). It would have been obvious to make the tubular member of Piotrovsky and Lindsay hollow since Hales shows that hollow insert members would be an art recognized

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equivalent and as such it would have been obvious to substitute a hollow tube for the tube as shown by Lindsay. The references disclose the basic inventive concept, substantially as claimed with the exception of the inner supporting structure or hollow insert occupying at least 50-70 percent of the volume of an associated portion of the appendage and the maximum diameter of the insert extending at least 70-75 percent across a diameter of the associated portion of the appendage. The examiner notes that it has been held that where the only difference between the prior art and the claimed device is a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art then the claimed device is not patentably distinct from the prior art. Furthermore, changes in size are generally recognized as being within the level of ordinary skill in the art and as such a modification on the size of the insert would be entirely obvious. See *in re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). Piotrovsky, Lindsay and Hales disclose the basic inventive concept, substantially as claimed, with the exception of the body portion being frustoconical in shape. Weis discloses an internal support structure for a figure or manikin that is covered in a soft, flesh-like outer covering (column 2 lines 3-17) including a hollow frustoconical shaped insert (54) positioned therein (Figs. 1, 9 & 10). The references disclose a cylindrical insert as opposed to a frustoconical shaped insert but, Weis discloses that the use of hollow frustoconical shaped inserts in molded figures would be an art-recognized equivalent at the time of invention. Therefore, one of ordinary skill in

the art would have found it obvious to substitute the cylindrical insert for the frustoconical shaped insert of Weis. Furthermore, changes in shape are generally held to be within the level of ordinary skill in the art. *See in re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

4. Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piotrovsky (4470784), Lindsay (3350812) and Hales (2129421). Piotrovsky discloses a hollow body portion due to its having a cavity or space therein with support braces (Fig. 2) that will form the inner supporting structure of an appendage for a toy figure (Fig. 3) with at least one engagement portion having a first engagement portion in the form of a cylindrical boss (36) for pivotably connecting the insert to another portion of the toy figure such as the torso (Fig. 1) and a second engagement portion formed by a tab (34) that engages the limb portion of the toy (Fig. 2). The boss is attached to the tab (34) which has a plurality of reinforcement ridges formed to extend perpendicularly outwardly from along the periphery of the tab and engage one of the braces (Fig. 2). The insert is also equipped with a plurality of pins and pegs (56, 46) for stabilizing the insert within a mold so as to injection mold the toy figure (Fig. 8). The insert is shaped to partially conform to an outer surface of the appendage (Fig. 8). The tab and boss each have a substantially semicircular edge that is configured to rotate smoothly within an outer covering of the toy figure (Fig. 2, column 2 lines 58-63). The hollow body insert is meant for use within a toy figure having a torso and limbs (Fig. 1) made of a soft flesh-like outer layer molded over the insert (column 2 lines 58-63). Piotrovsky discloses the basic inventive concept, with the exception of the body portion being formed of a first

and second body segments attachable by a hollow dowel and hollow boss so as to maintain a hollow space. Lindsay discloses an insert member (Figs. 1 & 2) having an enclosed tubular body portion for maintaining a space within an appendage of a toy figure being attached to a pivot member (Figs. 1 & 2). It would have been obvious to one of ordinary skill in the art to have a portion of the insert be an enclosed tubular member with a pivot element since such a modification would have involved a mere change in the shape of the insert. Changes in shape are generally held to be within the level of ordinary skill in the art. *See in re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Piotrovsky and Lindsay disclose the basic inventive concept, with the exception of the tubular member being hollow. Hales discloses an internal insert for a toy doll consisting of hollow tubular members (Fig. 9). It would have been obvious to make the tubular member of Piotrovsky and Lindsay hollow since Hales shows that hollow insert members would be an art recognized equivalent and as such it would have been obvious to substitute a hollow tube for the tube as shown by Lindsay. The references disclose the basic inventive concept, with the exception of the insert having first and second body segments attachable together by a hollow dowel and a hollow cylindrical boss. In regard to the insert being formed of two detachable segments, the examiner notes that it would have been an obvious matter of design choice to make the insert body of detachable elements, since such a modification would have involved a mere separation of parts. *See in re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). Although the references do not disclose a hollow dowel on a first body segment or a cylindrical hollow boss on a second segment the examiner notes that such

limitations would have been an obvious matter of design choice to a person of ordinary skill in the art since Applicant has not disclosed that utilizing a hollow dowel or a cylindrical boss to attach the segments provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the integral body insert disclosed by the references since an internal insert for a toy doll was still created. The references disclose the basic inventive concept, substantially as claimed with the exception of the inner supporting structure or hollow insert occupying at least 50-70 percent of the volume of an associated portion of the appendage and the maximum diameter of the insert extending at least 70-75 percent across a diameter of the associated portion of the appendage. The examiner notes that it has been held that where the only difference between the prior art and the claimed device is a recitation of the relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art then the claimed device is not patentably distinct from the prior art. Furthermore, changes in size are generally recognized as being within the level of ordinary skill in the art and as such a modification on the size of the insert would be entirely obvious. See *in re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

5. Claims 25-29,31-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piotrovsky (4470784), Lindsay (3350812), Hales (2129421) and Weis



as applied above with reference to claim 1 and further in view of Ryan (3277601). The references disclose the basic inventive concept with the exception of an engagement portion at an opposing end of the body portion relative to the tab and boss engagement portion taking the form of a recessed circular rack for connecting to a part of the limb. Ryan discloses a body portion with a tab and boss at one end (Fig. 9) and at an opposed end a circular rack (Fig. 12) for engaging with another portion of a limb (Fig. 9). It would have been obvious to one of ordinary skill in the art to have an engagement portion in the form of a circular rack in order for an upper limb portion and a lower limb portion to move relative to each other allowing for realistic movement of the toy device. In regard to the limitation of the rack being recessed, it would have been an obvious matter of design choice to a person of ordinary skill in the art to recess the rack since Applicant has not disclosed that recessing the rack provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the circular rack disclosed by the references since a moveable joint is still created.

#### ***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711